

- (4) Claims 1-4, 11-12, 23-26, 49-52, 59-60 and 62-63 under 35 U.S.C. §102(b) as anticipated by EP 0 527 625 (Cummings);
- (5) Claims 5-8, 15-18, 31-34, 41-44 and 53-56 under 35 U.S.C. §103(a) as unpatentable over Neumiller '681 as applied to the above claims;
- (6) Claims 9-10, 13-14, 19-22, 35-36, 45-46 and 57-58 under 35 U.S.C. §103(a) as unpatentable over Neumiller '681 as applied to the above claims, and further in view of U.S. Patent No. 5,716,921 (Neumiller '921);
- (7) Claims 11-12 and 27-36 under 35 U.S.C. §103(a) as unpatentable over Michael as applied to the above claims;
- (8) Claims 9-10, 13-14, 19-22, 45-46 and 57-58 under 35 U.S.C. §103(a) as unpatentable over Michael as applied to the above claims, and further in view of Neumiller '921; and
- (9) Claims 59-65 under 35 U.S.C. §103(a) as unpatentable over Neumiller '681 or Michael as applied to the above claims, and further in view of Svoboda.

Claims 1, 2 and 62 are the only pending independent claims. Applicants claim hard surface cleaning compositions including a particular combination of

components wherein the compositions have less than about 4% by weight volatile organic compound (VOC) content. The compositions include at least one low-volatile non-VOC evaporative organic solvent that has limited solubility in water of less than 20% and reduces surface tension of the composition to less than 40 dynes/cm. The claimed cleaning compositions provide acceptable cleaning without streaking or hazing in the absence of volatile compounds, in particular alcohols (page 2, paragraph 005). The applied art does not recognize the problem addressed by applicants or the claimed combination in a cleaning composition having a VOC content of less than 4% by weight. When considered as a whole, the teachings of the applied references do not teach or suggest the claimed compositions.

The Court of Appeals for the Federal Circuit, in considering a rejection under 35 U.S.C. §102, stated:

"For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference." *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). These elements must be arranged as in the claim under review, ... [references omitted]."

In re Bond, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Thus, anticipation under §102 is not present with regard to the pending claims. The applied references do not provide any teaching as to the claimed VOC content for a cleaning composition or as to a composition with the claimed VOC

content including the defined solvent claimed. Accordingly, the applied references do not teach each and every element of the claimed invention.

The Examiner asserts that the claimed VOC content would be inherently present based on the components present in the compositions of the applied references. However, as stated by the Court of Appeals for the Federal Circuit in In re Robertson, 49 USPQ2d 1949, 1950-1951 (Fed. Cir. 1999) -

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *Id.* at 1269, 20 USPQ2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ2d 323, 326 (C.C.P.A. 1981)."

That the claimed limitations are not necessarily present and are at most mere probabilities or possibilities can be seen from further differences between the claimed compositions and the teachings of the applied art. For example, Neumiller '681 teaches at column 2, lines 13-19, that non-volatiles tend to complex to self in drying and pull away from the glass resulting in streaking. The invention disclosed in Neumiller '681 involves the inclusion of specified alcohols. The examples set forth include compositions having a VOC content outside applicants'

currently claimed amount. The claimed compositions provide cleaning in the absence of alcohols (page 2, lines 17-18). Thus, Neumiller '681 provides no recognition or teaching as to the claimed cleaning compositions with a VOC content of less than 4% by weight. At the most, such is merely possible once applicants' disclosure is known and improper hindsight is used to select a particular combination as claimed.

Michael also does not contain any teaching as to VOC content but rather is directed to specialized zwitterionic surfactants in a cleaning composition. The examples set forth in Michael also include compositions having a VOC content clearly above the claimed VOC content level. Michael also requires the composition to have a pH of at least 9.5 (column 2, lines 24-25), whereas the claimed composition can have a pH of 2 or above (claims 23 and 24) or of 2 to 13 (claims 25 and 26).

Svoboda teaches a thickened glass cleaner containing a polymer and two alcohols, i.e., a linear alcohol and a non-streaking alcohol (column 1, lines 41-46) and has a pH of at least 7. No disclosure regarding VOC content is present in Svoboda.

Cummings, at page 8, Example 2, discloses composition C which is stated to be the same as composition A of Example 1 except that composition C includes diethylene

glycol hexyl ether (DEGHE) rather than ethylene glycol hexyl ether (EGHE). Composition A is stated to be in accordance with the disclosed invention and as providing the desired results, but composition C does not. DEGHE is a useful solvent according to applicants' claimed invention. At page 9, Example 6 of Cummings, addition of isopropanol to the inventive composition is stated to be preferred. The addition of isopropanol increases the VOC content of the composition. Examples set forth at page 13 of Cummings, based on the inclusion of 7% isopropanol are in clear excess of applicants' claimed VOC content.

Accordingly, none of Neumiller '681, Michael, Cummings or Svoboda, each applied alone under 35 U.S.C. §102, teach each and every element of the claimed invention. Further, the non-disclosed feature of the VOC content being less than 4% by weight is not necessarily present in the compositions of the applied art. The mere probability or possibility of the missing feature being present is not sufficient to find anticipation within the meaning of 35 U.S.C. §102. Withdrawal of the §102 rejections is therefore respectfully requested.

As to the rejections under 35 U.S.C. §103 applying the same references of Neumiller '681 and Michael alone or in combination with Neumiller '921 or Svoboda, also do not teach or suggest the claimed compositions. For a proper

rejection, the claimed compositions must be determined to be obvious from a fair reading of the prior art as a whole and requires a comparison of the subject matter claimed with the prior art as a whole. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Rothermel and Waddell, 125 USPQ 328, 331-332 (CCAA 1960); and In re Aufhauser, 158 USPQ 351, 353 (CCPA 1968).

The rejection of the Examiner makes it clear that select parts of the prior art disclosures must be selected based on applicants' own teaching in view of the teachings in the applied art which teach away from the claimed compositions as noted above. This is using improper hindsight. Thus, as the Court of Appeals for the Federal Circuit stated in In re Rouffet, 149, F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998):

"As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and

inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570. 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed."

In the case at hand, there is no motivation to select the parts of the references selected by the Examiner and to combine them in such a manner as to provide the claimed invention.

As the court noted in In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976),

"A determination under 35 U.S.C. §103, however, requires consideration of the entirety of the disclosure made by the two references to those skilled in the art." (at 146) and

"The view that success would have been 'inherent' cannot, in this case, substitute for a showing of reasonable expectation of success. Inherency and obviousness are entirely different concepts." (at 148, emphasis added) and

"The board held the view that Munro's teaching of higher pressures to increase reaction rate would have provided an obvious solution to the problem Rinehart encountered in scaling up the process of Pengilly. But Rinehart's problem was not the need for increased reaction rate. ... That problem is nowhere alluded to in either Pengilly or Munro, and of course no suggestion of a solution appears in either reference." (at 149, emphasis added).

This position by the Court of Customs and Patent Appeals has been adopted by the Federal Circuit and emphasized in cases such as In re Wright, 6 USPQ2d 1959 (1988) where the Court held that whether a novel structure is or is not obvious requires cognizance of the properties of that structure and the problem which it solves viewed in light of the teachings of the prior art. See, also, Diversitech Corporation vs. Century Steps, Inc., 7 USPQ2d 1315, 1318 (Fed. Cir. 1988), where the law set forth in In re Wright and In re Rinehart, and similar cases, was acknowledged. Thus, in making a determination of obviousness, it is essential to consider the problem facing the inventor, which none of the applied references did.

None of Neumiller '681, Michael, Neumiller '921 (which is applied in combination with either Neumiller '681 or Michael) or Svoboda (applied in combination with Neumiller '681 or Michael) recognize the problem addressed by applicants' claimed invention, much less teach or support the particular combination of components to provide a composition with a VOC content of less than 4% by weight. As stated by the Court of Appeals for the Federal Circuit in In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) -

"The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this

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process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. [References omitted]. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure."

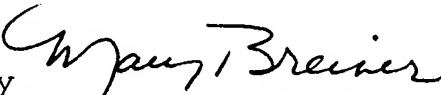
In the case at hand, it is not possible to extrapolate from the teachings of the prior art to the claimed invention. To do so is tantamount to applying an "obvious to try" standard. This standard was rejected by the court in In re Mercier, 185 USPQ 774, 779 (CCPA 1975).

Accordingly, applicants submit that the claims as rejected under 35 U.S.C. §103 are not rendered obvious within the meaning of §103 and, therefore, respectfully request withdrawal of the §103 rejections.

Reconsideration and allowance of the claims are respectfully urged.

Respectfully submitted,

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